

P21475.A06



#8/Election
4-29-03
JA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Kazumasa AYUKAWA et al.

Group Art Unit: 3682

Appln. No. : 09/961,365

Examiner: M. Charles

Filed : September 25, 2001

For : THIN AUTOTENSIONER

RESPONSE TO RESTRICTION REQUIREMENT WITH TRAVERSE

Assistant Commissioner of Patents
Washington, DC 20231

RECEIVED

APR 21 2003

Sir :

GROUP 3600

In response to the Examiner's Restriction Requirement of March 20, 2003, setting a one month period for response extending until April 21, 2003 (April 20, 2003 being a Sunday), Applicants elect the invention identified by the Examiner as Group I, an autotensioner, including claims 1-6, with traverse.

Applicants respectfully traverse the Restriction Requirement. The Examiner has characterized the inventions of Groups I (claims 1-6), II (claims 7-11), and IV (claims 14-20) as combination and subcombination. The Examiner states that "the combination as claimed does not require the particulars of the subcombination as claimed because the autotensioner of claims 1-6 does not require the torsion spring being twisted and house (sic) in a cup as in claims 7-11". The Examiner further states that "the autotensioner of claims 1-6 does not require the friction member with a plurality of grooves that brakes the rocking arm of claims

14-20". However, contrary to the Examiner's assertions, independent claim 20 does not recite a friction member with a plurality of grooves that brakes the rocking arm. Therefore, the subcombination as claimed in claim 20 does not require any particulars that are not required by the combination as claimed in claims 1-6. Further, the restriction requirement is incomplete since the required two way distinctness has not been demonstrated. See MPEP § 806.05(c). In particular, the Examiner has not established that the subcombination and combination inventions are distinct since the Examiner has not shown, in addition to the claimed combination not requiring the particulars of the subcombination, that the subcombination has utility by itself or in other combinations.

The Examiner has characterized the inventions of Groups I (claims 1-6), II (claims 7-11), IV (claims 14-20), and III (claims 12 and 13) as product made and process of making. The Examiner has stated that "the method steps can be made to assembly (sic) a vibration damper for a chain drive".

However, even if the Examiner's characterization of Groups I, II, and IV as defining a combination and subcombination and of Groups I, II, IV, and III as defining product made and process of making were to be considered correct, Applicants respectfully request that all of the inventions defined in the claims 1-20, nevertheless, be examined in the instant application, pursuant to the guidelines set forth in MPEP § 803. That is, the Examiner is respectfully requested to reconsider the requirement and find that there would not appear to

be a “serious burden” on the Patent and Trademark Office in examining claims directed to the non-elected inventions since the Examiner will have to search for the autotensioner in combination with a friction member and the process for making an autotensioner while searching for the autotensioner.

It would appear that the search for the inventions identified by the Examiner would be coextensive or at least significantly overlap. That is, if the Examiner were to perform a search for the invention of Group I, there would not appear to be a serious burden in continuing the examination of the other inventions of Groups II, III, and IV. For this reason, and consistent with office policy as set forth in MPEP § 803, Applicants respectfully request that the Examiner reconsider and withdraw the Requirement for Restriction.

For the foregoing reasons, it is submitted that the Requirement for Restriction in this application is improper and it is respectfully requested that it be reconsidered and withdrawn.

Additionally, Applicants request clarification on the disposition of the Election of Species Requirement of the Official Action issued December 12, 2002. On January 8, 2003, Applicants responded to the Election of Species Requirement, electing Specie I, with traverse. However, the Restriction Requirement issued March 20, 2003 followed without any mention of the previous Election Requirement. Therefore, it is presumed that the Election of Species Requirement issued December 12, 2002 has been withdrawn, and Applicants respectfully request confirmation of the same.

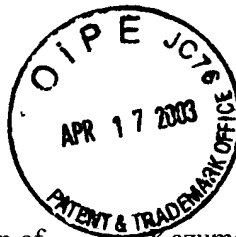
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Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the below listed telephone number.

Respectfully submitted,
Kazumasa AYUKAWA et al.

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Attorney Docket No. P21475

In re application of : Kazumasa AYUKAWA et al.

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THE COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231**RECEIVED**

APR 21 2003

GROUP 3600

Sir:

Transmitted herewith is a Response to Restriction Requirement with Traverse in the above-captioned application.

☐ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.☐ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.☐ An Information Disclosure Statement, PTO Form 1449, and references cited.☒ No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 20	*20	0	x 9=	\$	x 18=	\$0.00
Indep. Claims: 6	**6	0	x 42=	\$	x 84=	\$0.00
Multiple Dependent Claims Presented			+140=	\$	+280=	\$0.00
Extension Fees for Month				\$		\$0.00
Total:				\$	Total:	\$0.00

*If less than 20, write 20

**If less than 3, write 3

☐ Please charge my Deposit Account No. 19-0089 in the amount of \$_____.☐ A Check in the amount of \$_____ to cover the *filing/extension* fee is included.☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.☒ Any additional filing fees required under 37 C.F.R. 1.16.☒ Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 CFR 1.136)(a)(3).

With ? *Lyndal Reg. No.*
Bruce H. Bernstein
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